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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,808	02/12/2004	Marc W. Todd	50037.211US01	5841

.27488 7590 01/29/2007
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EXAMINER

BELL, CORY C

ART UNIT	PAPER NUMBER
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2164

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/777,808	Applicant(s) TODD ET AL.	
	Examiner Cory C. Bell	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/12/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-23 have been examined.

Response to Arguments

With regards to the rejections under 35 USC 112, the applicant's arguments are persuasive and the rejections have been withdrawn.

With regards to the rejections under 35 USC 101, the applicants arguments are not persuasive as the specification lacks support of "tangible computer-readable medium." It is suggested that the applicant amend the phrase to computer-readable storage medium, which is supported in the specification and will result in a tangible medium.

With regards to the rejection of claim 1 under 35 USC 102, the applicants arguments are not persuasive. Applicant is further directed to Figure 7 "recent contacts" paras 66 that further teach the recent contacts list. Furthermore with regards to the association of the contact to the recent item. The recent contacts list display a list of contact names which are associates to a contact record of the entire my contacts list see para 66.

With regards to the rejections of claims 11 and 18, the applicants arguments are not persuasive as they on the recitations made in the claim 1 argument.

With regards to the official notice taken for claims 9, 17, and 22, in order to properly refute the official notice the applicant why this feature is not considered to be common knowledge or well-known in the art. See MPEP 2144.03. Thus, as the applicants argument is merely a blanket assertion the argument is not persuasive.

With regards to the Official Notice taken for claims 10 and 23, the official notice is now considered to be admitted prior art in conjunction with MPEP 2144.03 [R-1] C.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The specification contains material that alludes to a computer readable medium encompassing non-tangible mediums, thus the claim fails to provide a useful concrete and tangible result and is non-statutory.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7, 11-15, and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2004/0119732, known hereafter as Grossman.

4.1. *As per independent claim 1*, Grossman teaches the claim limitations as follows:

determining a recent item based on an access to the item;(Para 11) associating the recent item with a contact maintained in a contact list when the item has an associated

contact(Para 11); placing the recent item in a recent items list that includes all recently accessed items;(Para 11) generating the recent items list such that the recent item is only shown once within the recent items list;(Figure 4 and 5 and para 11) and displaying the recent items list.(Para 48)

- 4.2. *As per dependent claim 2*, Grossman teaches the claim limitations as follows: The method of claim 1, wherein determining the recent item further comprises determining a time associated with a communication associated with the contact. (Para 11)
- 4.3. *As per dependent claim 3*, Grossman teaches the claim limitations as follows: The method of claim 1, wherein determining the recent item further comprises determining a frequency associated with a communication associated with the contact. (Para 11)
- 4.4. *As per dependent claim 4*, Grossman teaches the claim limitations as follows: The method of claim 2, further comprising determining a frequency associated with the communication. (Para 11)
- 4.5. *As per dependent claim 5*, Grossman teaches the claim limitations as follows: The method of claim 1, further comprising replying to the recent item by using any available communication method.(Para 52)
- 4.6. *As per dependent claim 6*, Grossman teaches the claim limitations as follows: The method of claim 5, wherein the communication method is selected from a set comprising a telephone call, an IM message, an SMS message, MMS message and an email. (Paras 4, 14, and 52)

- 4.7. *As per dependent claim 7*, Grossman teaches the claim limitations as follows: The method of claim 1, wherein the recent item list is limited to a predetermined number of recent items.(Para 49)
- 4.8. *As per independent claim 11*, Grossman teaches the claim limitations as follows: a communications connection configured to receive a communication;(paras 36 and 37) a display configured to display a recent items list;(para 38 and para 11) and a recent items application configured to perform actions, including: determining a recent item; (Para 11) associating the recent item with a contact maintained in a contact list when recent item is based on the communication;(Para 11) placing the recent item in the recent items list that includes all recently accessed items;(Para 11) generating the recent items list such that the recent item is only shown once within the recent items list;(See Claim 1 Rejection) and displaying the recent items list on the display. (See Claim 1 rejection)
- 4.9. *As per dependent claim 12*, Grossman teaches the claim limitations as follows: The system of claim 11, wherein determining the recent item further comprises determining a time associated with the communication. (A time associated with a communication must be determined to provide the recent items list as described in para 11)
- 4.10. *As per dependent claim 13*, Grossman teaches the claim limitations as follows: 1The system of claim 12, wherein determining the recent item further comprises determining a frequency associated with the recent item. (Para 11)
- 4.11. *As per dependent claim 14*, Grossman teaches the claim limitations as shown in the rejection of claim 5.

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4.12. *As per dependent claim 15*, Grossman teaches the claim limitations as shown in the rejection of claim 7.

4.13. *As per independent claim 18*, Grossman teaches the claim limitations as shown in the rejection of claim 1.

4.14. *As per dependent claim 19*, Grossman teaches the claim limitations as shown in the rejection of claims 2 and 4.

4.15. *As per dependent claim 20*, Grossman teaches the claim limitations as shown in the rejection of claim 5.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8, 11, 12, 16, 18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Sprint Online User's Guide PCS Phone Handspring Treo 300 User Guide, known hereafter as Treo.

As per independent claim 1, Treo teaches the claim limitations as follows: determining a recent item based on an access to the item;(Page 94 Call history) associating the recent item with a contact maintained in a contact list when the item has an associated contact(Page 94 Call History, shows recent communication aliased to contact names); placing the recent item in a recent items list that includes all recently accessed items;(Page 94 Call History) generating the recent items list such that the recent item is only shown once within the recent items list;(Page 94 Call History) and displaying the recent items list.(Page 94 Call History)

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As per independent claim 8, Treo teaches the claim limitations as follows:

Wherein determining the recent item further comprises determining when a communication associated with the recent item is private and when the communication is private marking the as a non-recent item and not including the recent item in the recent items list. (Page 72 by not being displayed it call history the recent item is marked as a non-recent item.)

4.16. *As per independent claim 11, Treo teaches the claim limitations as follows: a*

communications connection configured to receive a communication;(Page 94) a display configured to display a recent items list;(page 94) and a recent items application configured to perform actions, including: determining a recent item;(page 94)associating the recent item with a contact maintained in a contact list when recent item is based on the communication;(Page 94) placing the recent item in the recent items list that includes all recently accessed items;(Page 94) generating the recent items list such that the recent item is only shown once within the recent items list;(See Claim 1 Rejection) and displaying the recent items list on the display. (See Claim 1 rejection)

4.17. *As per dependent claim 12, Treo teaches the claim limitations as follows: The system of claim 11, wherein determining the recent item further comprises determining a time associated with the communication. (Page 94)*

4.18. *As per dependent claim 16, see claim 8 rejection above.*

4.19. *As per dependent claim 18, see claim 1 rejection above.*

4.20. *As per dependent claim 21, see claim 8 rejection above.*

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9-10, 17, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grossman in view of Official Notice.

6.1. *As per dependent claims 9, 17, and 22*, Grossman teaches the claims upon which claims 9, 17, and 22 are dependant, but fails to expressly disclose the time of the access to an item being displayed in the title bar when the item is selected. However, the examiner takes official notice that it would have been well known in the art at the time of the invention to display the time that a contact was last communicated with, for example cell phones recent calls lists, in the title bar when a recent item is selected. Thus it would have been obvious to one of ordinary skill in the art to include this feature as it would convey more information to the user about recent communications.

6.2. *As per dependent claims 10 and 23*, Grossman teaches the claims upon which claims 10 and 23 are dependant, but fails to expressly disclose being able to enable or disable the display of the list via a setting. The examiner takes official notice that it was well known in the art at the time of the invention to uses setting to enable or disable the display of certain modules, features, or shortcuts. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to include this feature as it would allow the user to customize the interface to suit their particular tastes and needs.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6760431 and US 6,901,559.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cory C. Bell whose telephone number is (571) 272 2736. The examiner can normally be reached on m-f 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272 4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


SAM RIMELL
PRIMARY EXAMINER